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**United States Patent and
Trademark Office
Examiner: I. Yucil
Art Unit: 1636**

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Ann S. Hobbs, Ph.D.

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SENDER'S ASSISTANT:

Carol Cascio

ASSISTANT'S PHONE NUMBER:

202-344-4738

DATE:

May 23, 2005

CLIENT/MATTER NUMBER:

38644-175286

PAGES, EXCLUDING COVER:

17

MESSAGE:

Re: U.S. Application No. 08/711,961

The following are attached:

- a. Urgent Request for Status;
- b. Request for Continued Examination Under CFR 1.114 dated April 27, 2004;
- c. Petition to Withdraw Erroneous Notice of Abandonment;
- d. Copy of January 22, 2004 Request for Reconsideration with date stamped receipt;
- e. Copy of March 1, 2004 Denial of Request.

Certificate of Transmission under 37 CFR 1.8 is attached.

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Revised PTO/SB/97 (08-00)

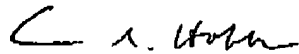
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on May 23, 2005.
Date

- a. Urgent Request for Status;
- b. Request for Continued Examination Under CFR 1.114 dated April 27, 2004;
- c. Petition to Withdraw Erroneous Notice of Abandonment;
- d. Copy of January 22, 2004 Request for Reconsideration with date stamped receipt;
- e. Copy of March 1, 2004 Denial of Request.



Signature

Ann S. Hobbs, Ph.D. (Reg. No. 36,830)
Typed or printed name of person signing Certificate

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MAY 23 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Appeal No. 2001-1881

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694

PATENT TRADEMARK OFFICE

URGENT REQUEST FOR STATUS

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:


This is a request for the status of the above-referenced application, and a response to the Petition filed on April 27, 2004. A copy of the filed papers is attached, including copies of the PTO date stamped receipt on April 27, 2004; the Request for Continued Examination under 37 CFR 1.114; Petition to withdraw Erroneous Notice of Abandonment; the January 22, 2004 Request for Reconsideration with date stamped receipt; and the March 1, 2004 Denial of Request.

The undersigned has made several telephone calls to the Office without result. The Petitions Branch informed the undersigned that this was the Examiner's responsibility. The Examiner believes it is the responsibility of the Petitions Branch.

Serial No. 08/711,961

An early response to this paper is respectfully requested.

Respectfully submitted,



Ann S. Hobbs, Ph.D.

Registration No. 36,830

VENABLE

P.O. Box 34385

Washington, D.C. 20043-9998

Telephone: (202) 962-4800

Telefax: (202) 962-8300

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Enclosures

DC2/ 650480V1

119553
Venable Filing NumberAttorney/LA: ASH/cfc
PTO Due Date: _____
Date Filed: April 27, 2004TM Official
Gazette Date: _____Atty. Docket No: 38644-175286
Re: Branstrom et al.
Application No: 08/711,961Appl'n Filing
Date: September 6, 1996
Issue Date: _____
Trademark
Reg. No: _____Patent No.: _____
Trademark: _____Opposition/Cancellation
No: _____

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

U.S. PTO FEES ENCLOSED

- ☐ Transmittal Sheet For
☐ Fee Transmittal Letter
☐ New U.S. Provisional Application
☐ Submission Of Corrected Formal Drawings (____ Sheets, Figs. _____)
☐ Invention Declaration
☐ U.S. National Stage Application of PCT Application
☐ Translation of International Application
☐ New U.S. TM Application (____ specimens)
☐ Rule 53(d) Continued Prosecution Application
☐ Substitute Specification
☐ Rule 53(b) Continuation or Divisional Application (*attach copy of specification, claims, drawings & declaration*)
☐ Priority Document-Cert. Copy of Appln.#: _____; Country _____
☐ Date Filed: _____
☒ Request for Continued Examination (RCE) under 37 CFR 1.114
☒ Petition to Withdraw Erroneous Notice of Abandonment
☒ Copy of January 22, 2004 Request for Reconsideration with date stamped receipt
☒ Copy of March 1, 2004 Denial of Request
☐ IDS w/ PTO SB/08 a/k/a PTO Form-1449 (____ References)
☐ AMENDMENT/ Request for Reconsideration
☐ Amendment/ ☐ Preliminary Amendment
☐ Petition For Extension Of Time
☐ Notice of Appeal
☐ Appeal Brief (*in triplicate*)
☐ Reply Brief (*in triplicate*)/ ☐ Request for Oral Hearing
☐ Confirmation of Hearing Petition
☐ Issue Fee Transmittal
☐ Certificate of Correction
☐ Maintenance Fee Transmittal
☐ Power of Attorney
☐ Response to Notice to File Missing Parts
☐ Response to Notice to File Missing Requirements
☐ Response to Restriction Requirement
☐ Petition to Revive
☐ Sequence Listing - CDR Enclosed? ☐ Yes ☐ No
☐ Status Inquiry
☐ Request for Non-Publication
☐ Request to Rescind Non-Publication Request
☐ Notice of Opposition (*Please list all documents in Other section*)

____ Filing Fee
 ____ Surcharge Fee
 ____ Additional Claim Fee
 ____ Recordation/Indexing Fee
 ____ IDS Fee
 ____ Extension Fee
 ____ Notice of Appeal Fee
 ____ Brief on Appeal Fee
 ____ Oral Hearing Request Fee
 ____ Petition Fee
 ____ Issue Fee
 ____ Publication Fee
 ____ Maintenance Fee
 ____ TM Statement of Use
 ____ 8 Affidavit Fee
 ____ 8 and 15 Affidavit
 ____ TM Renewal Application Fee
 ____ Notice of Opposition Fee
 ____ TM Extension of Time Fee
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Appeal No. 2001-1881

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694

PATENT TRADEMARK OFFICE

REQUEST FOR RECONSIDERATION

U.S. Patent and Trademark Office
Mail Stop: U.S. Board of Patent Appeals and Interferences
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Applicants request reconsideration of the Decision on Appeal issued December 22, 2003, affirming the obviousness-type double patenting rejection over prior U.S. Patent No. 5,824,538. A Terminal Disclaimer was filed in the application on October 17, 2003, a copy of which is attached hereto. It is respectfully submitted that the Terminal Disclaimer overcomes the obviousness-type double patenting rejection. Accordingly, it is requested that the Board reverse the double patenting rejection and allow the patent to issue..

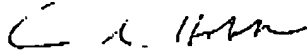
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Serial No. 08/711,961

It is believed that no fees are required. However, if the Patent Office deems that any fees are necessary, authorization is hereby granted to charge any required fees

Deposit Account No. 22-0261

Respectfully submitted,



Ann S. Hobbs, Ph.D.
Registration No. 36,830

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Washington, D.C. 20043-9998
Telephone: (202) 344-4800
Telefax: (202) 344-8300

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Venable Filing Number

Attorney/LA

Ann S. Hobbs

PTO Due Date:

Date Filed:

October 17, 2003

TM Official Gazette Date:

Atty. Docket No: 38644-175286

Re: Branstrom et al.

Application No: 08/711,961

Patent No.:

Trademark:

Opposition/Cancellation No:

Filing Date: September 8, 1996

Issue Date:

Trademark Reg. No:

The following items were received from Venable, Washington, D.C., by the U.S. Patent & Trademark Office:

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☐ Fee Transmittal Letter
☐ New U.S. Provisional Application (pages of specification/claims)
☐ Formal Drawings (sheets, Figs.)
☐ Invention Declaration
☐ U.S. National Stage Application of PCT Application
☐ Translation of International Application
☐ New U.S. TM Application (specimens)
☐ Rule 53(d) Continued Prosecution Application
☐ Substitute Specification
☐ Rule 53(b) Continuation or Divisional Application (attach copy of specification, claims, drawings & declaration)
☐ Priority Document-Cert. Copy of Appn.#: ; Country
☐ Date Filed:
☐ Request for Continued Examination (RCE) under 37 CFR 1.114
☐ Request for Reconsideration
☐ Application Data Sheet
☐ Assignment w/Cover Sheet
☐ IDS w/ PTO SB/08 a/k/a PTO Form-1449 (references)
☐ Response
☐ Amendment/☐ Preliminary Amendment
☐ Petition/Request for Extension of Time (two mo. ext.)
☐ Notice of Appeal
☐ Appeal Brief (In triplicate)
☐ Reply Brief (In triplicate)/ ☐ Request for Oral Hearing
☐ Confirmation of Hearing Petition
☐ Issue Fee Transmittal and publication fee
☐ Certificate of Correction
☐ Maintenance Fee Transmittal
☐ Power of Attorney
☐ Response to Notice to File Missing Parts
☐ Response to Notice to File Missing Requirements
☐ Response to Restriction Requirement
☐ Petition to Revive
☐ Sequence Listing - CDR Enclosed? ☐ Yes ☐ No
☐ Status Inquiry
☐ Request for Non-Publication
☐ Request to Rescind Non-Publication Request
☒ Terminal Disclaimer
☐ TM Statement of Use
☐ Extension of Time (mo. ext.)
☐ Declaration Under 8
☐ Declaration Under 8 and 15
☐ TM Renewal Application
☐ Notice of Opposition (Please list all documents in Other section)
☐ Amendment to Alleged Use
☐ Other: (Please describe below)

Filing Fee

Surcharge Fee

Additional Claim Fee

Recordation/Indexing Fee

IDS Fee

Extension Fee

Notice of Appeal Fee

Brief on Appeal Fee

Oral Hearing Request Fee

Petition Fee

Issue Fee

Publication Fee

Maintenance Fee

TM Statement of Use

8 Affidavit Fee

8 and 15 Affidavit

TM Renewal Application Fee

Notice of Opposition Fee

TM Extension of Time Fee

\$130.00 Total Fees Paid

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BRANSTROM et al.

Appl. No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

Art Unit: 1636

Examiner: I. Yucel

Atty. Docket No. 38644-175286

Customer No.

26694
PATENT TRADEMARK OFFICESUBMISSION OF TERMINAL DISCLAIMERU.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Enclosed is a Terminal Disclaimer for the above-identified patent application.

Please charge the required fee and any other fee that may be necessary to Deposit

Account No. 22-0261.

Respectfully submitted,

Ann S. Hobbs, Ph.D.
Registration No. 36,830VENABLE
P.O. Box 34385
Washington, D.C. 20043-9998
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**TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT**Docket Number (Optional)
38644-175286

In re Application of: Arthur A. Branstrom et al.

Application No. 08/711,961

Filed: September 6, 1996

For: BACTERIAL DELIVERY SYSTEM

The owner, Government of the United States, as represented by the Secretary of the Army of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,824,538. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☒ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☐ The undersigned is an attorney of record.

Elizabeth Arwine
Signature

9/3/03
Date

ELIZABETH ARWINE
Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/711,961	09/06/1996	ARTHUR A. BRANSTROM	003/030/SAP	9506

7590 03/01/2004

MCMR-JA (JOHN MORAN)
 US ARMY MEDICAL RESEARCH
 AND MATERIEL COMMAND
 FORT DETRICK
 FREDERICK, MD 217025012

EXAMINER

YUCEL IREM

ART UNIT

1636

PAPER NUMBER

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

STAFF JUDGE ADVOCATE
 FORT DETRICK, MD
 2004 MAR -3 AM 7:40

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

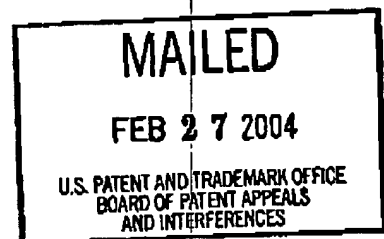
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ARTHUR A. BRANSTROM, DONATA R. SIZEMORE,
and JERALD C. SADOFF

Appeal No. 2001-1881
Application No. 08/711,961

ON BRIEF



Before WINTERS, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

REQUEST FOR REHEARING

On December 22, 2003, this panel issued a decision on appeal in which we summarily affirmed the obviousness-type double patenting. In that decision, we noted:

Even though we now have new claims 56, 57, 59-62 and 64-65 before us, appellants do not dispute that the new claims are subject to the obviousness-type double patenting rejection affirmed in the May Decision on Appeal. Appellants' only remarks were that they would file a Terminal Disclaimer, which has not been filed at this time. See Paper No. 29. Under these facts, we summarily affirm the obviousness-type double patenting rejection as to newly entered claims 56, 57, 59-62 and 64-65.

Appeal No. 2001-1881
Application No. 08/711,961

Page 2

Decision on Appeal mailed December 22, 2003, page 2.

In the Request for Reconsideration, Appellants request reconsideration of the above decision on the grounds that a terminal disclaimer was filed in the application on October 17, 2003. Appellants have also attached a copy of the Terminal Disclaimer to the Request for Reconsideration. The function of the Board in the ex parte context, however, is to review rejections. The Board does not perform examining functions in the first instance, and a terminal disclaimer must be proffered to the relevant Technology Center and the examiner, rather than to the Board. See MPEP § 1490.

Moreover, an obviousness-type double patenting rejection of claim 45-55 was before us in the Decision on Appeal mailed May 30, 2003, and as appellants had not argued the merits of the rejection, and as a terminal disclaimer had not been filed, that rejection was also affirmed. The Request for Reconsideration does not provide an explanation as to why the terminal disclaimer filed October 17, 2003, after our first decision on appeal, was timely filed.¹ Accordingly, appellants request for rehearing is denied.

¹ See In re Deters, 515 F.2d 1152, 1157, 185 USPQ 644, 48 (CCPA 1975) ("Since no terminal disclaimer was timely filed, we sustain . . . [the obviousness-type double patenting] rejection."); Cf. In re Jursich, 410 F.2d 803, 807, 161 USPQ 675 (CCPA 1969), footnotes and citations omitted, ("The record shows that appellants' assignee filed a terminal disclaimer in the Patent Office after the board decision which the board refused to consider because it was not timely presented or considered by the examiner. Appellants assign error in that action by the board, arguing that the terminal disclaimer 'eliminated the double patenting issue in the present case.' However accurate that statement may be, we cannot consider the disclaimer here. . . .").


Page 3


Appeal No. 2001-188
Application No. 08/711,961

CONCLUSION

For the reasons set forth above, Appellant's Request for Rehearing is denied.

REQUEST FOR REHEARING-DENIED


Sherman D. Winters)
Administrative Patent Judge)


Donald E. Adams
Administrative Patent Judge


Lora M. Green
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

Appeal No. 2001-1881
Application No. 08/711,961

Page 4

MCMR-JA John Moran
US Army Medical Research
And Material Command
Fort Detrick
Frederick, Maryland 21702-5012

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